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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1033-LB1011	
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		First Named Inventor Douglas F. Reynolds, et al.	
		Art Unit 2614	Examiner GAUTHIER, Gerald
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ 41,067</p> <p><i>Chad M. Herring</i> Signature</p> <p>Chad M. Herring Typed or printed name</p> <p>512-327-5515 Telephone number</p> <p><i>05-21-2007</i> Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Douglas F. Reynolds, et al.

Title: SYSTEM AND METHOD FOR FACILITATING A CUSTOM RING IN CONNECTION WITH A CALL

App. No.: 10/774,351 Filed: February 6, 2004

Examiner: GAUTHIER, Gerald Group Art Unit: 2614

Customer No.: 34456 Confirmation No.: 5256

Atty. Dkt. No.: 1033-LB1011

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**REMARKS IN SUPPORT OF
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed February 28, 2007 (hereinafter, "the Final Office Action"), Applicant respectfully requests review and reconsideration of the Application in view of the following issues.

The Final Rejection Is Improper

Under M.P.E.P. §706.07(a), the Final rejection is improper because the Examiner has introduced a new ground of rejection for claims 1-30 and 33-47 that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Accordingly, the Final Office Action is improper because it is premature.

Claims 1-53 Are Allowable

The Office has rejected claims 31, 32 and 48-53 under 35 U.S.C. § 101 as directed to non-statutory subject matter, at page 2 of the Final Office Action. Further, the Office has rejected claims 1-30 and 33-47 under 35 U.S.C. § 101 "because the software in claims 31 and 48

runs the method claims.” *See the Final Office Action*, p. 2, paragraph 1. Applicants respectfully traverse the rejections.

With respect to claims 1-30 and 33-47, the Office has erred by asserting that claims 1-30 and 33-47 are non-statutory subject matter “because the software in claims 31 and 48 runs the method claims.” The basis for rejecting claims 1-30 and 33-47 not only misstates the law, but it mischaracterizes the claims. First, it is well-settled that methods implemented in software may constitute patentable subject matter. *See, e.g., NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005); and *see AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (the Court upheld claims to a method for enhancing a long-distance telephone call message record as being “comfortably within the broad scope of patentable subject matter.”). Second, none of the claims 1-30 or 33-47 depend from claims 31 and 48. Accordingly, the assertion that “the software in claims 31 and 48 runs the method claims” imposes a limitation that is not recited in the claims, has not been asserted by the Applicants, and is irrelevant to the issue of patentability. Claims 1-30 and 33-47 do not depend from claim 31 or from claim 48. Accordingly, the computer readable medium of claims 31 and 48 do not necessarily “run the method claims” as asserted by the Office. Accordingly, the rejection of claims 1-30 and 33-47 under 35 U.S.C. §101 is improper and should be withdrawn.

Further, the rejection misrepresents the claims, because independent claims 18, 26, and 43 are system claims, and not method claims as suggested by the Office. Claim 18, for example, recites “a ring tone delivery system” that includes “an interface operable to receive a calling signal that indicates a request to complete a call from a calling party to a called party,” and “a network node communicatively coupled to the interface and operable to deliver packetized information representing a calling party selected ring tone to the called party.” The interface and the network node recited in claims 18-25 are structural components that constitute patentable subject matter under 35 U.S.C. §101.

Claim 26 recites “a system for facilitating a select ring tone in connection with a call” that includes “an electronic device operable to support telephonic communication, the electronic device comprising a housing component,” a memory located within an enclosure at least partially formed by the housing component, the memory storing ring tone information representing the

select ring tone.” Claim 26 further recites “a user interface for the electronic device operable to receive a user input indicating a desire to place a call to the called party,” and “an output engine operable to initiate communication of the ring tone information to the called party such that a telephonic device of the called party outputs the select ring tone to indicate the call, wherein the select ring tone is selected by a calling party.” Claims 27-30 and 47 also recite structural components that constitute patentable subject matter under 35 U.S.C. §101.

Moreover, independent claim 43 recites “A system for facilitating a select ring tone in connection with a call” that includes “an electronic device operable to support telephonic communication, the electronic device comprising a housing component” and “a memory located within an enclosure at least partially formed by the housing component, the memory storing ring tone information representing the select ring tone and including an advertisement.” Claim 43 further includes “a user interface for the electronic device operable to receive a user input indicating a desire to place a call to a called party” and “an output engine operable to initiate communication of the ring tone information to the called party such that a telephonic device of the called party outputs the select ring tone to indicate the call.” Claims 44-46 also recite structural components that constitute patentable subject matter under 35 U.S.C. §101.

Additionally, claim 1 recites “a call indication method” that includes “recognizing a request to complete a voice over internet protocol (VoIP) call to a called party” “receiving custom ring information from a calling party of the VoIP call, the custom ring information representing a desired ring tone to be played to the called party,” and “initiating delivery of the custom ring information to the called party.” The initiation of delivery of the custom ring information to the called party constitutes a tangible result. Whether the method is performed using hardware or software is immaterial, because the method constitutes patentable subject matter. Accordingly, claims 1-17 include subject matter that is patentable under 35 U.S.C. § 101.

Applicants respectfully remind the Office that 35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. (emphasis added).

In *Diamond v. Chakrabarty*, the Supreme Court recognized that Congress chose the expansive language of 35 U.S.C. § 101 so as to include “anything under the sun that is made by man” as statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). While the Courts have recognized some limitations to patentability, under *State Street Bank & Trust Company v. Signature Financial Group, Inc.*, the Federal Circuit has acknowledged that software methods may be patentable subject matter, provided such methods produce a tangible result. See *State Street*, 149 F.3d 1368 (Fed. Cir. 1998). Accordingly, claims 1-17 are patentable subject matter.

With respect to claims 31, 32 and 48-53, independent claims 31 and 48 recite “a computer readable medium.” Applicants direct the Examiner’s attention to Annex IV of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published in the OG Notices of 22 November 2005, and available at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.html>.

In particular, the first paragraph of section (a) of Annex IV of the Interim Guidelines states that a “claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.” Additionally, the second paragraph of section (a) of Annex IV of the Interim Guidelines states:

[A] claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Applicants note that each of claims 31 and 48 recite “a computer-readable medium having computer-readable data.” Claim 31 recites that the computer readable data is “to initiate completion of a VoIP call” and “to direct delivery of information to a telephonic device of the called party in a format that allows the telephonic device to output the calling party selected ring tone as an indication of an incoming call.” Claim 48 recites that the computer readable data is to “initiate completion of the VoIP call” and “direct delivery of the information to a telephonic device of the called party in a format that allows the telephonic device to output the calling party

selected ring tone as an indication of an incoming call.” Both claims 31 and 48 recite computer readable data to perform processes that have a tangible output (i.e. directing delivery of the information to a telephonic device of the called party in a format that allows the telephonic device to output the calling party selected ring tone as an indication of an incoming call). Accordingly, claims 31, 32 and 48-53 constitute statutory subject matter under 35 U.S.C. § 101.

CONCLUSION

The Final Office Action has failed to cite any references that discloses or suggests each and every element of any of the claims. Further, the Office has rejected system and method claims on an unsupported theory that the claims because “the software in claims 31 and 48 runs the method claims.” Applicants have pointed to multiple errors in the Final Office Action, including that the finality of the Final Office Action is premature, which errors should be overturned or withdrawn. Accordingly, the pending claims constitute statutory subject matter and are allowable. Applicant therefore requests reconsideration and withdrawal of all pending rejections.

Respectfully submitted,

05-29-2007
Date

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